

REMARKS

Claims 17-21 were examined by the Office, and all claims are rejected. Prosecution of the present application was reopened in response to the Appeal Brief filed October 23, 2006. With this response claims 17 and 18-21 are amended. Claim 17 is the only independent claim. Applicant respectfully requests reconsideration and withdrawal of the rejections in view of the amendments and the following discussion.

Applicant respectfully notes that in section 1 of the Office Action the Office states that claims 1-16 and 22-25 have been canceled. Claims 1-16 and 22-25 are still pending in the application, but have been withdrawn from consideration in response to the restriction requirement of March 7, 2005. Therefore, claims 1-16 and 22-25 have not been canceled, and applicant respectfully requests that the Examiner correctly note this on any subsequent Office Action Summary forms.

Claim Rejections Under § 112

In section 3, on page 2 of the Office Action claim 17 is rejected under 35 U.S.C. § 112, second paragraph as indefinite. Claim 17 is amended to clarify that "information" in line 8 refers to "presence information," as recited previously in claim 17. Therefore, applicant respectfully submits that claim 17 as amended is definite. Claims 19-21 are amended to similarly reflect this amendment.

Claim Rejections Under § 103

In section 5, on page 3 of the Office Action claims 17-21 are rejected under 35 U.S.C. § 103(a) as unpatentable over Dalal et al. (U.S. Publ. Appl. No. 2002/0065894) in view of Armstrong et al. (U.S. Patent No. 6,807,423). Applicant respectfully submits that the cited references, alone or in combination, fail to disclose or suggest all of the limitations recited in claim 17. The cited references at least fail to disclose or suggest a central server responsive to presence information relating to a invited user registered at a presence server for use in deciding whether content is sent to the invited user, stored or refused, as recited in claim 17. Furthermore, there is no motivation to combine the cited references, because there is no motivation to include geographic information in the system discussed by Dalal.

Applicant respectfully submits that the cited references fail to disclose or suggest that the central server decides whether content is sent to the invited user, stored or refused. Dalal only discloses that data received from a messaging client 12 is forwarded by the presence processor 15 to the processor 21 in the unified instant messaging processor (UIM) 10. See Dalal paragraph [0017]. The message formatting and routing entity 23 then checks with the user preference store 26 to determine whether the message should be forwarded, if not the UIM proceeds to wait for new data. However, Dalal at most discloses that the UIM determines whether to forward the message or presence data, and does not disclose that the server decides whether to send, store or refuse content based on presence information relating to the invited user registered at the presence server, as recited in claim 17. The determination of whether to forward data is not the same as deciding whether to send, store or refuse content, because the UIM only determines whether to forward the data or not, and does not have the option of either refusing or storing the data. Therefore, for at least this reason claim 17 is not disclosed or suggested by the cited references.

Furthermore, as previously acknowledged, the filing date of Dalal (November 30, 2000) is after the priority date of the present application, November 8, 2000. However, Dalal claims priority to provisional application No. 60/168,881 filed December 3, 1999, and therefore is only available as a reference if the provisional application supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. § 112, first paragraph. See MPEP § 2136.03. In rejecting claim 17 of the present application, the Office relies upon paragraph [0017] of Dalal to teach a central server responsive to presence information relating to a invited user registered at a presence server for use in deciding whether content is sent to the invited user, stored or refused. Presumably, the Office is relying upon the statements that the message and presence formatting and routing entities (23, 24) check the user preference store 26 to determine whether the data should be forwarded. However, this subject matter relied upon by the Office is not supported by the provisional application in a manner that complies with the written description requirement or the enablement requirement of § 112, first paragraph. See MPEP § 2161.

The written description requirement of the first paragraph of § 112 requires a disclosure that describes the relied upon subject matter in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the subject matter. See MPEP § 2163.02. The provisional application of Dalal makes no mention of determining whether data

should be forward or not. Section 2 of Appendix A of the provisional application only mentions that “instant message should be forwarded to the destination device of the user’s choice in real time.” However, there is no disclosure in the provisional application of Dalal that sufficiently describes that a determination is made as to whether or not to forward data, because the provisional application only mentions that messages should be forwarded. Therefore, the subject matter relied upon in rejecting claim 17 at least fails to comply with the written description requirement of § 112, first paragraph.

Furthermore, the enablement requirement of § 112, first paragraph requires a disclosure sufficient to allow one of skill in the relevant art to make and use the invention, and in this case, the subject matter relied upon in rejecting the claims. See MPEP § 2164. However, as mentioned above, the provisional application of Dalal is completely devoid of any discussion of a UIM processor that is capable of determining whether or not to forward data. Without any direction or suggestion from the provisional application, one of skill in the art would be required to engage in undue experimentation using the discussion of the provisional application to arrive at the subject matter relied upon in Dalal to reject the claims. See MPEP § 2164.01. Therefore, the provisional application of Dalal also fails to comply with the enablement requirement of § 112, first paragraph.

For at least the reasons discussed above, Dalal is not available as a reference, because its filing date is after the priority date of the present application, and the disclosure of relied upon in rejecting the claims is not supported by the provisional application. See MPEP § 2136.03 III. Since Dalal is not available as a reference to reject the claims, and Armstrong does not disclose or suggest the limitations recited in claim 17, the claim 17 is believed to be patentable.

Furthermore, even if Dalal is available as a reference, which applicant does not admit, the Office acknowledges on page 4 of the Office Action that Dalal fails to disclose that the information relating to presence pertains to a spatial location of the registered user, and relies upon Armstrong for these teaching. However, there is no motivation to combine the cited references, because Dalal has nothing to do with the geographic location of a user. In fact, Dalal only mentions in paragraph [0003] of keeping track of the “online availability” of users, which is specifically directed to the online status of users, and has nothing to do with geographic or physical location in the sense of keeping “track” of a user as asserted by the Office. Therefore, location information is superfluous to the system discussed in Dalal, since Dalal only focuses on

the online availability of users. As such, the Office has engaged in impermissible hindsight reasoning by using applicant's disclosure as a template and piecing together teachings from the cited references without showing a proper motivation to combine the cited references. For at least this additional reason, claim 17 is not disclosed or suggested by the cited references, alone or in combination.


Claims 18-21 ultimately depend from independent claim 17, and are believed to be patentable at least in view of their dependencies.

Conclusion

Applicant respectfully submits that the present application is in condition for allowance, and such action is earnestly solicited. The undersigned hereby authorizes the Commissioner to charge Deposit Account No. 23-0442 for any fee deficiency required to submit this response.

Respectfully submitted,

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